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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,030	03/09/2000	James A Thomson	96-0296-96544	4331

26710 7590 12/18/2002

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EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 12/18/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

File

Advisory Action

Application No.
09/522,030

Applicant(s)
Thomson, J. A.

Examiner
Joseph Weitach

Art Unit
1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Dec 6, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-14 and 17

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☒ Other: IDS-see attached

DEBORAH J. REYNOLDS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Art Unit: 1632

Section 5:

Applicants note the amendments to the claim and argue the specification teaches the use of FGF and that the addition of FGF in various culturing conditions produced a unexpected synergistic affect on culture primate cells. Applicants acknowledge the teaching of the references, noting however that stem cells from various species demonstrated different requirements for various factors. Applicants argue that none of the reference provide the teaching demonstrating that the addition of FGF to the culture media for primate cells would have produced the synergistic affect disclosed in the present specification. Applicant's arguments have been fully considered and found persuasive in part. Upon review of the specification (in particular in the specification on page 7), Examiner would agree that the addition of basic FGF to Knockout D-MEM media provides a specific condition that would not have been expected by the cited references . However, the claims encompass the use of any FGF, any serum free condition, and simply activating the FGF receptor. As acknowledged by Applicants, examiner would agree that optimum culturing conditions for one cell may not produce the same effect in another cell. It is noted that the courts have held that consistent with the rule that all evidence of nonobviousness must be considered when assessing patentability, the PTO must consider comparative data in the specification in determining whether the claimed invention provides unexpected results. See *In re Margolis*, 785 F.2d 1029, 1031, 228 USPQ 940, 941-42 (Fed. Cir. 1986). However it is also well established that the evidence presented to rebut a prima facie case of obviousness must be commensurate in scope with the claims to

Art Unit: 1632

which it pertains. See *In re Dill*, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979). In the instant case, while the evidence in the instant specification provides support for an unexpected effect of bFGF in culturing primate cells in specific serum free conditions, the instant claims encompass any serum free culture condition and any FGF or affecting the FGF receptor. Applicants arguments are not found persuasive because the unexpected effect disclosed in the specification is not commensurate in scope with the pending claims. Further, given the breadth of the claims, there was a reasonable teaching and expectation that the addition of growth factors would be necessary in the optimization of culturing conditions for primate embryonic cells, and that the addition of these factors would result in better culturing conditions.

Section 10:

The information disclosure statement filed December 6, 2002, attachment to paper number 12, fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p) and fails to comply with 37 CFR 1.97(d) because it lacks the petition fee set forth in 37 CFR 1.17(i). It has been placed in the application file, but the information referred to therein has not been considered.